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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,861	03/18/2004	Kristin L. Ficery	10761.1484-02	7726
81331 7590 07/29/2010 Accenture/Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue Washington, DC 20001-4413			EXAMINER JOHNSON, GREGORY L	
			ART UNIT 3691	PAPER NUMBER
			NOTIFICATION DATE 07/29/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/802,861

Applicant(s)

FICERY ET AL.

Examiner

GREGORY JOHNSON

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the amendment filed May 4, 2010.

Status of Claims (as filed December 4, 2009)

2. Claims 1-15 and 17-30 are as previously presented. Claim 16 was amended. Claims 31-32 are new. **Claims 1-32** are pending.

Response to Arguments

3. The 35 U.S.C. § 103(c) disqualification of Heyns as prior art is acknowledged.
4. Applicant's argues (pg. 4) Zarb fails to teach or even suggest "calculat[ing] normalized information regarding the cost structure of the target company based on the financial data inputs" as recited in claim 1. This argument has been considered but is moot in view of the new grounds of rejection.
5. Applicant's also argues (pg. 4) Zarb fails to teach or even suggest "receiv[ing] cost levers based on the normalized diagnostic information" as recited in claim 1. This argument is not persuasive.

In response the Examiner respectfully disagrees with Applicant's assertion. Applicant's Figs. 3 & 4, as best understood, illustrate "Inventory Turns" and "Infrastructure Cost" as a cost levers for "Improving Deployment of Capital". This in turn helps to "Decrease Operating Costs"; which helps to "Increase NOPAT; which helps to improve Shareholder Value.

Now turning to Zarb, which discusses in ¶0117 the measuring the throughput characteristics (e.g. actual utilization and forecast realistic improvements) of physical assets, particularly property, plant and equipment assets (*Applicant's cost lever of infrastructure costs*). Zarb continues by teaching a key measure of throughput through a physical asset such as a warehouse is inventory turns (*another cost lever*). If a building can physically turn inventory (i.e., the inventory in the warehouse can be totally stocked and replenished) within twenty-four hours, the theoretical inventory turns for that warehouse would be 365 per year. This physical asset benchmark seeks to establish the upper limit of 365; baseline actual (real world) performance *and project the impact of future improvements (Applicant's improving deployment of capital)*. Questions such as "If we could improve the inventory turns through or major warehouse by ten percent, would we be able to close our satellite warehouses?" can be answered by the computations embodied by this physical asset benchmark.

In addition, throughout Zarb's specification, benchmarks are being assessed based on whether they would result in a cost savings or an increase in revenue. Zarb teaches determining a benefit of ownership provided by or associated with strategies by analysis of processes, roles and assets associated with the strategies; in which the Benefits of ownership associated with a strategy may include cost savings or cost avoidance and/or revenue enhancements (¶0038) (either of these would impact/improve shareholder value).

In view of the above, the Examiner maintains that Zarb teaches "receiv[ing] cost levers based on the normalized diagnostic information" as recited in claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1-2, 11-13, 15-16, 20, 26-28 and 30-32** rejected under 35 U.S.C. 103(a) as being unpatentable over Zarb, Pub. No. 2004/0039619 (hereinafter "Zarb"), in view of Quackenbush et al., Pub. No. 2003/0172014 (hereinafter "Quackenbush").

As per claim 16, Zarb teaches a computer-readable storage medium encoded with instructions, which when executed on a processor, perform a method comprising:

- receiving financial data inputs regarding a target company (§0047-0052 and §0056-0057; discusses obtaining information on a prospect company, for example, a company's annual report or 10K filing) ;
- displaying the normalized diagnostic information (§0048 and §0061; discusses a user analyzing the table 64 of Fig. 2);

- receiving cost levers (e.g. labor costs, employee efficiency, inventory turns, etc; Applicant's Fig. 4) based on the normalized diagnostic information (¶0004, ¶0038-0042, ¶0054, ¶0064, ¶0066, ¶0072-0076, ¶0082, ¶0096, ¶0117 and Figs. 8-10, 12, 15-16, 19-20 and 23; discusses and illustrates operational efficiency, inventory turns and costs, e.g. headcount (i.e. costs associated with processes, roles and assets));
- generating a cost reduction strategy for one or more of the cost levers (Abstract, ¶0001, ¶0046-0049, ¶0054-0062 and ¶0072-0076);
- correlating the cost reduction strategy with corresponding ones of the cost levers (¶0022, ¶0038, ¶0042 and ¶0072-0073; via mapping of roles, processes, and assets to a strategy);
- generating implementation information related to implementing the cost reduction strategy (Abstract, ¶0038, ¶0151, ¶0178-0179, ¶0190 and ¶0193; discusses a potential cost model that projects how days sales outstanding (the strategy) can be enhanced if the finance department role collaborated with external parties who are involved in sales order submission and subsequent invoice collection; people may be asked to rate their willingness to participate in one or more changes associated with a strategy, rate their expectation of a successful implementation of a strategy; and comparing implementation options (e.g., build versus purchase of equipment)); and

- outputting the cost reduction strategy and the implementation information (§§0189-0196; discusses communicating the strategy and implementation to various groups of people).

Zarb does not explicitly teach the following limitation; however, Quackenbush teaches the limitation:

- calculating normalized diagnostic information regarding the cost structure of the target company based on financial data inputs (§§0018 and claims 1-3, 10 and 25-26; via the system provides financial performance information by computing, for example earnings growth rates).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Quackenbush within Zarb for the motivation to provide the means for collecting the appropriate [financial] data in order to run analytic tools on said data (§§0007).

As to claim 1, Zarb teaches an electronic network system adapted to generate cost reduction strategies for a target company, the network system comprising:

- a cost lever analysis tool (§§0197, §§0204, §§0210 and §§0218; via computer software, program, sets of instructions or code);
- a cost reduction strategy tool (§§0197, §§0204, §§0210 and §§0218; via computer software, program, sets of instructions or code);
- a generation module (§§0197, §§0204, §§0210 and §§0218; via computer software, program, sets of instructions or code);

- a linking module (§§0197, §§0204, §§0210 and §§0218; via computer software, program, sets of instructions or code);
- an implementation module (§§0197, §§0204, §§0210 and §§0218; via computer software, program, sets of instructions or code);
- an output module (§§0197, §§0204, §§0210 and §§0218; via computer software, program, sets of instructions or code); and
- at least one processor (§§0205, §§0208-0210; via processor 700 may comprise one or more microprocessors, computers, computer systems, etc.).

The remaining limitations of claim 1 are substantially equivalent to the limitations of claim 16, and are therefore rejected on the same grounds.

As per claim 2, Zarb teaches wherein said the implementation information includes at least one of case studies, implementation plans, integration implications, and *sample benefit and impact forecasts* (Abstract, §§0029-0033, §§0077, §§0118-0119, §§0136 and §§0156-0159).

As per claim 11, Zarb teaches wherein the cost lever analysis tool generates summary reports, the summary reports including at least one of metrics or diagnostic ratios of the target company (§§0046-0049 and Figs. 2-3).

As per claim 12, Zarb teaches wherein the summary reports include charts or diagrams comparing the metrics or the diagnostic ratios to baseline industry (§§0046-0049 and Figs. 2-3).

As per claim 13, Zarb teaches wherein the baseline industry information comprises metrics or diagnostic ratios pertaining to industry competitors of the target company (§0046-0049 and Figs. 2-3).

As per claim 15, Zarb teaches wherein at least one of the cost lever analysis tool, the cost reduction strategy tool, and the output module is located on server electronically accessible by remote users (§0197-0205 and Fig. 35).

Claim 20 recites an equivalent limitation to claim 2, and is therefore rejected using the same art and rationale as set forth above.

Claims 26-28 recite equivalent limitations to claims 11-13, respectively, and are therefore rejected using the same art and rationale as set forth above.

As per claim 30, Zarb teaches wherein the computer-readable storage medium is located on a network accessible to users to perform the method (§0197-0205 and Fig. 35), and wherein the financial data inputs are received electronically by the network from a remote electronic financial data repository (§0050 and Fig. 35).

As per claim 31, Zarb teaches wherein the cost lever analysis tool identifies the cost levers (§0072-0076 and Figs. 8-9).

As per claim 32, Zarb teaches wherein the implementation information constitutes an approach for implementing the cost reduction strategy (§0178; via implementation options).

9. Claims 3-4 & 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarb and Quackenbush as applied to claims 2 and 20 above, and further in view of Official Notice.

Note: Applicant's failure to adequately traverse the assertions made by the previous Examiner in the rejections of claims 3-4 and 21-22 (re: "hyperlink documents" and "documents can be cross-linked to each other") is taken to be admitted prior art [see MPEP 2144.03(C)].

As per claim 3, Zarb does not expressly disclose wherein said overviews comprise hyperlinked overview documents.

The Examiner takes Official Notice that it is old and well known in the art to provide hyperlinks for documents (See, e.g., claim 32 of Wallenius (U.S. 7,139,813) which discloses, teaches, and suggests hyperlinked and cross-linked documents). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sarno to include hyperlinked overview documents that link different documents (See plain meaning of hyperlink...Webster's Dictionary).

As per claim 4, Zarb does not expressly disclose wherein the documents can be cross-linked to each other.

The Examiner takes Official Notice that it is old and well known in the art to cross-link documents containing related subject matter (See, e.g., claim 32 of Wallenius (U.S. 7,139,813) which discloses, teaches, and suggests hyperlinked and cross-linked documents). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sarno to include cross-linking overview

documents for related business capabilities in order to provide quick and efficient comparison of relevant strategic objectives via a links for different documents (See plain meaning of hyperlink...Webster's Dictionary).

Claims 21-22 recite equivalent limitations to claims 3-4, respectively, and are therefore rejected using the same art and rationale as set forth above.

10. Claims 5-9, 17-19 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarb and Quackenbush as applied to claims 1, 2, 16 and 20 above, and further in view of Sarno, Pub. No. 2002/0042751 (hereinafter "Sarno").

As per claim 5, Zarb does not teach the following limitation; however, Sarno teaches the limitation: wherein a plurality of case studies are correlated with each cost reduction strategy (Abstract and ¶0156; discusses methods and software tools for generating financial summaries and business cases allowing, for example, *adjustments for continuous improvements*; and the use of case studies to develop a meaningful understanding of the financial value of a given purchase to the business operating in a particular industry).

Zarb teaches a system and method for analyzing and forecasting an organization's business processes and the cost and revenue impact of or change to physical, financial and human assets associated with the processes (¶0004).

Sarno teaches methods for analyzing and presenting user information for cost justification by providing tools for generating financial summaries and business cases allowing, for example, adjustments for continuous improvements (Abstract and ¶0164).

Both Zarb (§0038) and Sarno (§0115) teach methods for analyzing an organization to determine/reveal cost savings or cost avoidance actions that the organization may undertake; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the methods and apparatus for facilitating analysis of an organization as taught by Zarb, with the cost justification analysis methods as taught by Sarno, since the claimed invention is merely a combination of old elements (i.e. methods for analyzing the cost structure/expenses of an organization), and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007), Rational (G).

As per claim 6, Zarb does not teach the following limitation; however, Sarno teaches the limitation: wherein the implementation information includes case studies derived from more than one industry (§0156; via knowledge base information includes case studies which consider purchases in different industries such as legal, financial, government, technology, and other suitable industries).

As per claim 7, Zarb does not teach the following limitation; however, Sarno teaches the limitation: wherein the output module generates a cost-reduction strategy template for the target company (§0201; discusses a customized template; and the cost justification application may be customized by selecting or entering the personnel salaries and services affected by the proposed solution (vendor product), and designating whether they will *result in a savings or expenses*).

As per claim 8, Zarb does not teach the following limitation; however, Sarno teaches the limitation: wherein the cost reduction strategy template includes the implementation information (§§0186-0187, §§0190-0196 and §0201; discusses rules associated with a rollout form, spreadsheet/graphs reflecting costs and a customized template).

As per claim 9, Zarb teaches wherein the implementation information includes at least one of economic impacts, strategy goal summaries, expected implementation schedules and plans, projected cost considerations, and *projected key benefits* (§§0038-0039, §§0041, §§0049, §§0061, §§0098, §0167 and Figs. 13-14, 17-18 and 33-34).

Claims 17-19 recite equivalent limitations to claims 7-9, respectively, and are therefore rejected using the same art and rationale as set forth above.

Claims 23-24 recite equivalent limitations to claims 5-6, respectively, and are therefore rejected using the same art and rationale as set forth above.

11. **Claim 10 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarb and Quackenbush as applied to claims 1 and 16 above, and further in view of Sakui et al., Pub. No. 2003/0120577 (hereinafter "Sakui"), and Thomas et al., Pat. No. 6,832,211 (hereinafter "Thomas").

As per claim 10, Zarb does not explicitly teach the elements; however, Sakui teaches the elements:

- wherein the cost lever analysis tool further comprises a calculation module that calculates a total return to shareholders using a calculated return on

- invested capital (See Abstract, ¶¶0061 and Figs. 6-7 & 9-11; which discusses a means for calculating a return on invested capital),
- a calculated weighted average cost of capital (See Fig. 1, #114, which illustrates a means for calculating weighted average cost of capital),
 - a calculated organic growth (¶¶0002, ¶¶0046, ¶¶0064, ¶¶0069-0070, ¶¶0156 and ¶¶0169-0170; which discusses calculating a net operating profit after tax of an enterprise).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned calculations as taught by Sakui within Zarb for the motivation to provide a method for obtaining market efficiency value added (MEVA) that can be used as an index for evaluation of business performance (¶¶0005).

Neither Zarb nor Sakui teach the following element:

- a calculated merger and acquisition growth based on the financial input data.

Per Applicant's specification (page 62):

"The calculation of M&A growth 1070 entails the use of a strategic control map 1230 and distinguishes acquirer and non-acquirer strategies 1240 as discussed hereafter."

Per Applicant's specification (page 68):

"Strategic control map generally *compare the performance* of companies (e.g., as embodied by market-to-book values ratios or the *market values*) to the size or

book values of the companies" (**as interpreted** – compares market value to the book value of a company).

Thomas teaches that target valuations for company stocks are produced based on the strength and quality of their technology. The valuations are derived from a combination of indicators that measure the quality of companies' patented technology, and their commitment to research and development. Thomas also teaches that companies' market-to-book (MTB) ratio measures the relationship between the Market Value of a company (Share Price x Number of Shares Outstanding) and its Book Value (the value of the assets it has on its balance sheet). For example, if a company has a Book Value of \$10 million, and has 5 million outstanding shares priced at \$4 each, it has an MTB of 2 (\$20 million/\$10 million) (Abstract; col. 1, lines 15-19; col. 2, line 21 thru col. 3, line 3; and col. 5, line 19 thru col. 6, line 10).

Sakui teaches that through calculations performed by a computer for business performance-related indices and based on the results of these calculations, a business value related to measurement of performance of an entire enterprise can be displayed in a format that helps in making a decision in terms of management of said enterprise (Abstract, ¶0002-0006 and ¶0083). Thomas also teaches a method for evaluating a business to identify investment opportunities (see the cited reference passages above).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the combination of Zarb and Sakui, the method of calculating the relationship between the market value and book value as taught by Thomas to determine a total growth comprising an organic growth and a

mergers and acquisitions growth, since the claimed invention is merely a combination of old elements (i.e. valuations), and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143, Rational (G).

Claim 25 recites equivalent limitations to claim 10, and is therefore rejected using the same art and rationale as set forth above.

12. Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarb and Quackenbush as applied to claims 12 and 27 above, and further in view of Trainer, Pub. No. 2004/0039676 (hereinafter "Trainer").

As per claims 14 and 29, Zarb does not teach the following limitation:

- wherein the summary reports include shareholder return graphs, the shareholder return graphs comparing a growth compound annual growth rate to a spread for the target company and industry peers of the target company (Applicant's Fig. 6).

However, Trainer teaches a system and method for analyzing financial information of companies including accounting distortions based on extraction or elucidation of underlying economic data. Trainer teaches that the economics of a business, such as ROIC and WACC, drive the value of the business (see ¶0030-0034 and Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation (i.e. graph) as taught by Trainer within Zarb for the motivation to provide the proper method for measuring the profitability of a business via a graphical representation using ROIC-WACC (§0032 and Fig. 7).

Trainer also teaches that similar analysis can be performed with other accounting-based metrics (see §0030-0034 and Fig. 7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the graph as taught by Trainer, by replacing Enterprise Value/Average Invested Capital with CAGR, since the claimed invention is simply a substitution of one known element for another (i.e. financial metrics), and one of ordinary skill in that art would have recognized that the results of the substitution were predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of valuating a company (e.g. comparing financial metrics) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations (e.g. plotting a financial metric against ROIC-WACC) would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gerace, Pat. No. 5,848,396 – teaches a computer program that allows users to examine company data, compare several companies, or compare an SIC-code group; and to also compare companies using Compound Annual Growth Rate (CAGR)

“A value-based analysis of specialty chemical companies”; David Begleiter; Chemical Market Reporter – teaches using CAGR and ROIC-WACC to compare specialty chemicals companies (see at least Figs. 1 and 4)

Medtronic's chairman William George on how mission-driven companies create long-term shareholder value; William W George; The Academy of Management Executive – teaches that revenue growth increase leads to profit growth increases which leads to shareholder value increases

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GREGORY JOHNSON/
Examiner, Art Unit 3691